REMARKS

Reconsideration of the application is requested.

Applicant appreciatively acknowledges the Examiner's confirmation of receipt of applicant's claim for domestic priority under 35 U.S.C. § 120. The applicant respectfully requests that a similar acknowledgement be provided for the applicant's claim for foreign priority under 35 U.S.C. § 119(a)-(d) based on the German Patent Application 197 36 441.1, filed August 21, 1997.

Claims 1-11 and 13-18 are now in the application. Claims 1-3, 5, and 11 have been amended. Claims 14-18 have been added. *Claim 12 has been canceled to facilitate prosecution of the instant application.*

In item 2 on page 2 of the above-identified Office Action, claims 1-13 have been rejected as being fully anticipated by U.S. Patent No. 6,504,925 to *Schlachmann, et al.* (hereinafter '925) under 35 U.S.C. § 102(e).

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. In addition to the claims and the drawings, support for the changes to the amended claims may

be found on pages 3, 6, 9-11, and 13-17 of the specification

of the instant application.

Before discussing the prior art in detail, it is believed

that a brief review of the invention as claimed, would be

helpful. Claim 1 calls for, *inter alia*, a method of

determining a communication partners connection information

for a user including:

> providing a directory with a technical address and an
> identifier for each possible communication partner;
>
> **based on input from the user and on previous
> communication behavior of the user**, automatically
> obtaining at least one communication partner from the
> directory and suggesting to the user the possible
> communication partner.

Independent claim 11 contains similar language.

Claim 2 calls for, *inter alia*, the method as previously

described in claim 1 where the previously described directory

is sorted according to a call probability.

Claim 3 calls for, *inter alia*, the method as previously

described in claim 1 where the directory is a personal

directory generated **according to the previous communication

behavior of the user.**

Claim 4 calls for, *inter alia*, the method as previously described in claim 1 where the directory obtains technical address information for possible future communication partners from previous communication partners over a **predetermined period of time.**

Claim 5 calls for, *inter alia*, the method as previously described in claim 1 where technical address information from **previous communication partners** is collected **over a predetermined period of time** to form a predetermined directory. The method described in claims 5 also **sorts the predetermined directory according to call probability.**

New claim 14 calls for, *inter alia*, the method as previously described in claim 1 where the predetermined selection strategy is **based on a points key of combined criteria** including call frequency, time of last call, and possible communication partners whose at least one technical address or at least one identifier match at least part of the most recent user provided input.

New claim 15 calls for, *inter alia*, the method as previously described in claim 1 to suggest a communication partner **based on call frequency** between the user and each of the possible communication partners in the directory.

New claim 18 calls for, *inter alia*, the method as previously described in claim 1 where the input from the user is **phonetic information** that is used to obtain and to suggest a desired communication partner.

In contrast, the '925 reference discloses an apparatus that enables a telephone user to alphanumerically search and obtain telephone directory information about telephone subscribers from a telephone directory memory. The directory memory storing the subscriber information may include a large permanent data memory portion and a small non-permanent data memory portion. The small non-permanent data memory portion typically includes a finite list of recent contacts, but does not provide any information related to call frequency or potential phonetic relationships.

In the described and illustrated embodiments, '925 uses input from the user to perform alphanumeric searches of designated fields within the two directory memory portions. For example, one search might use part of a subscribers name while another search might use a partial phone number to locate a subscriber. However, the search methodology used in '925, once the directory is provided, is clearly and

exclusively limited to alphanumeric searches (see Figs. 3-7

and 19 in '925).

The applicant respectfully asserts that although '925 may

have identical search results to the instant application, the

methodology used to arrive at those results is clearly

different, so the similar or identical search results should

not be used as an indicator of anticipation under 35 U.S.C. §

102(e). The small non-permanent data memory portion of '925

typically includes a finite list of recent contacts, *e.g.*,

five contacts. In contrast, the instant invention according

to claims 3-6 includes a directory that is generated

according to the previous communication behavior of the user

"over a predetermined period of time" which could be five

calls or fifty calls. As such, identical directories, each

resulting from the methodology described in '925 and the

methodology described in the instant invention, could be

created if certain conditions are met.

For example, if the small non-permanent data memory portion

in '925 maintains a record of the last five contacts (e.g.,

Figs. 17 and 19) and the user only makes five calls within

"the predetermined period of time" the resulting two

directories would have identical entries. As such '925 **does**

not anticipate "recording technical addresses of the user's

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previous communication partners over a predetermined period
of time" as recited in claims 3-6 in the instant invention.

Therefore, although a search performed according to the
teachings in '925 may obtain similar search results when
compared to search results conducted according to the claims
of the instant application, the search performed according to
'925 is clearly not based on "previous communication **behavior**
of the user" as recited in claim 1 of the instant
application. As such, '925 searches are alphanumeric
searches based on a finite call log stored in the small non-
permanent memory portion, not searches based on monitored
communication **behavior** of the user. As such, the applicant
must respectfully traverse the assertion of the Examiner in
the aforementioned Office Action bridging pages 2 and 3, that
'925 suggests a subscriber from the directory to the user
based on "previous communication behavior of the user" as
recited in claim 1 of the instant application.

Moreover, the search criterion of '925 is exclusively based
on alphanumeric matching. Specifically, the input provided
by the user is alphabetically matched to entries in the
directory. Clearly, the displayed entries in '925 are not
selected "based on call probability" as recited in claim 2 of
the instant application. Additionally, the suggested

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directory entries are based on "call frequency" between the user and each one of the plurality of possible communication partners as recited in claims 15-17 of the instant application. Nor are the displayed directory entries in '925 based on "phonetic information" as recited in claim 18 of the instant application.

In item 3 on page 4, the Examiner indicates that U.S. Patent No. 4,633,041 to *Boivie, et al.* (hereinafter '041) and U.S. Patent No. 5,943,055 to *Sylvan* (hereinafter '055) were made of record because they were considered pertinent to the applicant's disclosure.

The '041 reference performs a search of the directory to narrow down the potential communication partners after each alphanumeric entry by the user. This enables the user to enter fewer letters of the desired communication partner before it is displayed in the directory. Clearly, the search performed in '041 is based on alphanumeric input from the user and not based on "previous communication behavior of the user" as recited in claim 1 of the instant application.

The '055 reference introduces a method and system for processing and presenting multiple functions at a telephone station through graphic objects. Exemplary functions include

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email, fax, and telephone services. The offered directory

functions are call logs and are not based on "previous

communication behavior of the user" as recited in claim 1 of

the instant application.

It is accordingly believed to be clear that none of the

references, whether taken alone or in any combination, either

show or suggest the features of claim 1 or claim 11. Claims

1 and 11 are, therefore, believed to be patentable over the

art. The dependent claims are believed to be patentable as

well because they all are ultimately dependent on either

claim 1 or claim 11.

In view of the foregoing, reconsideration and allowance of

claims 1-11 and 13-18 are solicited.

In the event the Examiner should still find any of the claims

to be unpatentable, counsel would appreciate receiving a

telephone call so that, if possible, patentable language can

be worked out.

Petition for extension is herewith made. The extension fee

for response within a period of one month pursuant to Section

1.136(a) in the amount of $110.00 in accordance with Section

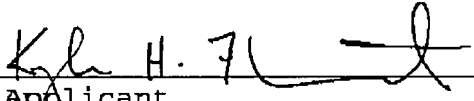1.17 is enclosed herewith.

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Please charge any other fees that might be due with respect

to Sections 1.16 and 1.17 to the Deposit Account of Lerner

and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

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_____   **Reg. No. 42,539**
For Applicant

KHF:cgm

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